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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/556,357

10/17/2006

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EXAMINER

TRIEU, THERESA

ART UNIT

PAPER NUMBER

3748

MAIL DATE

DELIVERY MODE

11/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/556,357	Applicant(s) HASEGAWA ET AL.	
	Examiner Theresa Trieu	Art Unit 3748	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-12 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-6, 13-19 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-12 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Nov. 10, 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>Nov. 10, 2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is responsive to the applicants' election filed on Oct. 17, 2008.

Election/Restrictions

1. Applicant's election without traverse of Group II, claims 7-12 and 20-22 being readable thereon, in the reply filed on Oct. 17, 2008 is acknowledged. Claims 1-6, 13-19 and 23 are withdrawn from consideration as being directed to a non-elected species.

Information Disclosure Statement

2. The information disclosure statement filed on Nov. 10, 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

3. Figures 19-21 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 7-10 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawabe et al. (Kawabe) (Publication Number JP 2002-235666).

Regarding claims 7-10 and 20, as shown in Fig. 5, Kawabe discloses a compressor comprising: a container 1; a compression mechanism 4 disposed in a lower portion of the container; a rotational motor 3 disposed in an upper portion of the container, the rotational motor having a stator 7A and a rotor 6; a coil end (not numbered; however, clearly seen in Fig. 5) provided on each of upper and lower ends of the stator; a discharge pipe (b1) provided on an upper end of the container; an oil reservoir 5 provided in a lower portion of the container; and a gap (not numbered; however, clearly seen in Fig. 5) provided between the rotational motor 3 and the container, the gap being operable to introduce working fluid, which is compressed by the compression mechanism, into an upper space of the container; and a substantially cylindrical dividing member (Sa) provided in the upper space of the container and being operable to divide the upper space into an inner space and an outer space (see Fig. 5); wherein the discharge pipe has an open end in the container 1, the open end being located inside the substantially cylindrical

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dividing member; and wherein the working fluid is discharged from the container through the discharge pipe; a gap is provided between an upper end of the dividing member and the container; the dividing member (Sa) is provided with a communication hole (not numbered; however, clearly seen in Fig. 5) between the inner space and the outer space; the dividing member (Sa) is provided inside the coil end provided on the upper end of the stator 7A; an upper portion of the container 1 is domical in shape.

6. Claims 7-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sakaino et al. (Sakaino) (Publication Number JP 58-170893).

Regarding claims 7-8, as shown in Fig. 2, Sakaino discloses a compressor comprising: a container 1; a compression mechanism 6 disposed in a lower portion of the container; a rotational motor 2 disposed in an upper portion of the container, the rotational motor having a stator 3 and a rotor 4; a coil end (not numbered; however, clearly seen in Fig. 2) provided on each of upper and lower ends of the stator; a discharge pipe 16 provided on an upper end of the container; an oil reservoir 18 provided in a lower portion of the container; and a gap (not numbered; however, clearly seen in Fig. 2) provided between the rotational motor 2 and the container 1, the gap being operable to introduce working fluid, which is compressed by the compression mechanism, into an upper space of the container; and a substantially cylindrical dividing member 12 provided in the upper space of the container and being operable to divide the upper space into an inner space and an outer space (see Fig. 2); wherein the discharge pipe 16 has an open end in the container, the open end being located inside the substantially cylindrical dividing member 12; and wherein the working fluid is discharged from the container

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1 through the discharge pipe 16; a gap is provided between an upper end of the dividing member 12 and the container 1.

7. Claims 7-10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Muramatsu et al. (Muramatsu) (Publication Number JP 61-205392).

Muramatsu discloses a compressor comprising: a container 1, 2; a compression mechanism 3 disposed in a lower portion of the container; a rotational motor 6, 9 disposed in an upper portion of the container, the rotational motor having a stator 9 and a rotor 6; a coil end (not numbered; however, clearly seen in Figs. 1-2) provided on each of upper and lower ends of the stator; a discharge pipe 4 provided on an upper end of the container; an oil reservoir 5 provided in a lower portion of the container; and a gap (G) provided between the rotational motor 6, 9 and the container 1, 2, the gap being operable to introduce working fluid, which is compressed by the compression mechanism, into an upper space of the container; and a substantially cylindrical dividing member 11 provided in the upper space of the container and being operable to divide the upper space into an inner space and an outer space (see Figs. 1-2); wherein the discharge pipe 4 has an open end in the container, the open end being located inside the substantially cylindrical dividing member 11; and wherein the working fluid is discharged from the container 1, 2 through the discharge pipe 4; a gap is provided between an upper end of the dividing member 11 and the container 1, 2; the dividing member 11 is provided with a communication hole (not numbered; however, clearly seen in Fig. 1) between the inner space and the outer space; the dividing member 11 is provided inside the coil end provided on the upper end of the stator 9.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawabe in view of legal precedent.

Kawabe discloses the invention as recited above; however, Kawabe fails to disclose a position of the dividing member with respect to the coil end. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have utilized the dividing member being provided outside the coil end provided on the upper end of the stator, since the dividing member would have performed equally well on inside/outside the coil end and the mere repositioning of parts not effecting the functioning of the device involves only routine skill in the art, *In re Japikse*, 86 USPQ 70.

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9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawabe in view of legal precedent.

Kawabe discloses the invention as recited above; however, Kawabe fails to disclose a shape of the dividing member. It would have been an obvious matter of design choice to have utilized an inner diameter of an upper portion of the dividing member is smaller than an inner diameter of a lower portion of the dividing member, since it has been held that a change in the shape of the element involves only routine skill in the art. *In re Dailey*, 149 USPQ 47 (CCPA 1966) (see MPEP §2144.04).

10. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawabe in view of legal precedent.

Kawabe discloses the invention as recited above; however, Kawabe fails to disclose a position of a cluster with respect to the rotational motor. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have utilized a cluster adapted to connect a lead wire from the rotational motor to the introduction terminal, wherein the cluster is symmetric with respect to a center axis thereof, the center axis being substantially coincident with a rotation center axis of the rotational motor, since the cluster would have performed equally well and the mere repositioning of parts not effecting the functioning of the device involves only routine skill in the art, *In re Japikse*, 86 USPQ 70.

11. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawabe in view of Yamasaki et al. (Yamasaki) (Patent Number 6,732,542).

Kawabe discloses the invention as recited above; however, Kawabe fails to disclose a working fluid used carbon dioxide.

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Yamasaki teaches that it is conventional in the art to utilize carbon dioxide is used as the working fluid (see col. 12, lines 43-48). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have utilized the carbon dioxide, as taught by Yamasaki in the Kawabe apparatus, since the use thereof would have provided gentle to the earth and less flammable and toxic.

Prior Art

12. The IDS (PTO-1449) filed on November 10, 2005 has been considered. An initialized copy is attached hereto.

Conclusion

13. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F.R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP §2163.06 II(A), MPEP §2163.06 and MPEP §714.02. The "disclosure" includes the claims, the specification and the drawings.

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Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theresa Trieu whose telephone number is 571-272-4868. The examiner can normally be reached on Monday-Friday 8:30am- 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on 571-272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TT

/Theresa Trieu/
Primary Examiner, Art Unit 3748